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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,942	08/20/2003	Man Chan	007198-538	5397

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EXAMINER

KUHNS, SARAH LOUISE

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/643,942

Applicant(s)

CHAN, MAN

Examiner

Sarah L. Kuhns

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 14-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Claims 14-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on April 29, 2005.

Applicant argues that claim 20 should be included in Group 1 with claims 1-13, which are directed to a candy, because it is also directed to a candy. However, as stated in the restriction requirement, the method of Group 2 can be used to create a product different from that of Group 1. Also, the product claimed in claim 20 is not the same invention as that of Group 1 because it does not require the printed edible starch sheet. Therefore, claim 20 is not rejoined.

Claim Objections

Claim 8 is objected to because of the following informalities: "ration" should be "ratio." Appropriate correction is required.

Claim 9 is objected to because of the following informalities: "0,7%" should be "0.7%." Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what is included in "and the like."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Pearce et al., U.S. 2003/0224090 A1. Pearce discloses a candy (paragraph 132) and an edible starch sheet being printed with an edible image (paragraphs 28 and 131) wherein the edible starch sheet contains corn starch (paragraph 198) and the edible image is formed with edible ink (paragraph 131).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bandongen, JP 03039044 A in view of Lazard et al., EP 0 547 551 A1. Bandongen discloses a candy including a substantially transparent candy layer and an edible starch sheet, wherein the edible starch sheet is printed with an edible image with the image side underneath and facing the transparent candy layer and the image is formed with an edible ink (abstract and brief oral translation). Bandongen does not specifically disclose corn starch, but teaches rice paper and any other suitable starch material may be used. Lazard discloses edible film compositions for use with candy (page 3, lines 41-46) and also teaches that it was well known to use corn starch in the forming of films (page 6, lines 55-58). As such, it would have been obvious to select corn starch as a suitable

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starch for use in the invention of Bandogen since the use of corn starch was conventional in the art.

Claims 2 and 8 are rejected U.S.C. 103(a) as being unpatentable over Bandongen, in view of Lazard and Wang, U.S. Patent 5,922,379. Bandongen does not disclose the sheet containing tapioca or potato starch. However, Lazard discloses that both tapioca starch and potato starch were commonly used in the forming of edible films (page 6, lines 55-58). Additionally, Wang teaches the use of a combination of starches, including corn starch and tapioca starch, in a thermoplastic composition (claim 9), such as a film, which is edible and can be used in food packaging products (column 2, lines 40-42). „Therefore, it would have been obvious to use a combination of the starches taught by Wang in any ratio in order to form a film with the desired properties.

Claims 3 and 4 are rejected under U.S.C. 103(a) as being unpatentable over Bandongen, in view of Lazard and Wang, in further view of Pearce. Bandongen does not appear to disclose the use of a thickener. However, Pearce discloses an edible film that can be used with candy as discussed above, and also discloses the use of sodium alginate and acacia gum as thickeners (paragraph 40). Therefore, it would have been obvious to use sodium alginate and acacia gum in the film of Bandongen, for their art-recognized purposes as thickening agents.

Claims 5-7 are rejected under U.S.C. 103(a) as being unpatentable over Bandongen, in view of Lazard et al., Rispoli et al., U.S. Patent 4,260,637. It is not clear from Bandogen as to how the edible sheet is attached to the candy. However, edible adhesives, such as that claimed, were well known to those of ordinary skill in the art.

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For example, Rispoli discloses the use of a solution (column 3, lines 50-54) containing gum Arabic and xanthan gum (column 3, lines 6-16) being used as an adhesive with a starch based food product. Therefore, it would be obvious to use a similar adhesive solution in the invention of Applicant because it is also a starch based food product.

Claims 9-13 are rejected under U.S.C. 103(a) as being unpatentable over Bandongen, in view of Lazard and Johnston et al., U.S. Patent 3,063,391. Bandongen does not disclose the inclusion of acid in the candy. However, it was well known to include acids, such as lactic acid and citric acid, in hard candies in order to enhance flavor and also was conventional to make hard candies using vacuum cookers, as evidenced by Johnston (column 1, lines 11-22).

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah L. Kuhns whose telephone number is 571-272-1088. The examiner can normally be reached on Monday - Friday from 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached at 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLK



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